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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD R. REISMAN

Appeal 2011-004918
Application 09/553,337
Technology Center 2100

Before MAHSHID D. SAADAT, ERIC B. CHEN, and
BRYAN F. MOORE, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR RECONSIDERATION

Appellant requests rehearing under 37 C.F.R. § 41.52 of our Decision on Appeal entered November 30, 2012 (“Decision” or “Dec.”) where we affirmed the Examiner’s final rejection of claims 114-122, 124-126, 128-141, 143-145, 147-155, 157-161, 163-173, 175-179, and 181-202.

The Request for Rehearing is *granted-in-part*.

ANALYSIS

First Appellant argues:

[T]he Board confuses which computers in Kleinerman are the client and the host. Kleinerman’s “host computer system” (or simply “HOST” as shown on the right side of Figure 1) is not a “client,” as stated in the Board Decision [and] the Board wrongly attributes “the claimed ‘the plurality of available online services’” to Kleinerman’s “second computer system.”

(Req. for Reh’g 7.)

Upon consideration of Appellant’s arguments, we further elaborate our original Decision to replace the full sentence at page 4, lines 6-12, with the following:

Kleinerman explains that one or more computer application programs (i.e., the claimed “functional request”) are simultaneously executed in one or more host computer systems under the control of a second computer system (i.e., the claimed “client interface”) that performs operations on data and instructions (i.e., the claimed “the plurality of available online services”) (Abstract), which includes use of an Application Program Interface (API) for controlling devices (col. 18, ll. 29-31).

In addition, a careful reading of the Decision indicates that language in Kleinerman that “performs operations on data and instructions” (Abstract) corresponds to the claimed “the plurality of available online services.”

Other than alleging typographic errors in the Decision (Req. for Reh’g 7), Appellant has failed to “state with particularity the points believed to have been misapprehended or overlooked by the Board” as required by 37 C.F.R. § 41.52 with respect to the claim limitation “an application programming interface (API) configured to provide a generic client interface for communicating a functional request associated with the application function to any one of the plurality of available online services,” as recited in claim 114.

Second, Appellant argues that “the Board appears to misunderstand the Examiner’s reasoning and rationale supporting the rejection.” (Req. for Reh’g 7.) In particular, Appellant argues that the “Examiner cited to Kleinerman’s references to ‘seamless migration’ and the like, those citations were to support the Examiner’s contention that Kleinerman taught other limitations relating to the claimed API . . . not the ‘in the background’ limitation . . .” (Req. for Reh’g 9; *see also* Req. for Reh’g 10-11.) Accordingly, Appellant argues “[t]he Board has confused different parts of the claim and different aspects of the rejection. (Req. for Reh’g 9.)

Claim 114 recites “*third instructions*, executable at the user station, for presenting a graphical user interface, *generating the functional request*, and *communicating the functional request to the online service using the API*” (i.e., labeled part “C” by Appellant (Req. for Reh’g 2))(emphasis added) and “*wherein the third instructions receive via the API a response to the functional request from the online service in the background*, thereby permitting the graphical user interface to continue operation” (i.e., labeled part “E” by Appellant (*id.*)) (emphasis added). In other words, the recitation of “third instructions . . . generating the functional request, and

communicating the functional request to the online service using the API” provides an antecedent basis for the limitation “a response to the functional request from the online service.”

The bridging paragraph at pages 4-5 of our Decision states that:

The Examiner found that the *seamless migration between the host computer and the second computer of Kleinerman*, implemented by the managers (i.e., the API, the Watch Host Patterns, the Central Event Manager, the Window Manager, the Presentation Manager, and the Communications Manager) and Application Interface Modules (AIMs) of Kleinerman, corresponds to the limitation “*a response to the functional request from the online service in the background, thereby permitting the graphical user interface to continue operation.*”

(Dec. 4-5 (emphases added).) Accordingly, the “seamless” migration of Kleinerman between the host computer and the second computer corresponds to the claim language “a response to the functional request from the online service.” Furthermore, any discussion of the claim language “a response to the functional request from the online service” (i.e., labeled part “E” by Appellant) would include a discussion of the claim language “third instructions . . . generating the functional request, and communicating the functional request to the online service using the API” (i.e., labeled part “C” by Appellant), which provides the antecedent basis.

For clarification purposes, we further elaborate our original Decision to replace the full sentence at page 5, lines 15-19, with the following:

Kleinerman “provides a machine-independent, information-exchange environment and subsequent method for transferring and exchanging data among applications and hosts.” (Col. 5, ll. 32-36.) Kleinerman further explains that by interposing AIMs between users and host programs (col. 9, ll. 10-13) provides a “‘seamless’ migration for the user community across changes to the host system, applications and

the host system application programs on the connectivity requirements between the host and the secondary computer” (col. 9, ll. 21-25). Therefore, Kleinerman teaches the limitation “a response to the functional request from the online service.”

Third, Appellant argues that:

[T]he fact that the host computer in Kleinerman is multitasking does not suggest that the API operates in the background. There is simply no relation between host multitasking and whether the API operates in the foreground or background. To be sure, the Board Decision offers no explanation for such a relationship, and the Examiner never alleged such a relationship.

(Req. for Reh’g 11.) Similarly, Appellant argues that:

The fact that there is an invisible session layer for communication is unrelated to whether the API operates in the foreground or the background. Again, the Board Decision offers no explanation for such a relationship, and the Examiner never alleged such a relationship.

(Req. for Reh’g 12.)

Upon consideration of Appellant’s arguments, we elaborate and highlight our original Decision to replace the two full sentences at page 5, lines 7-14, with the following:

In particular, as noted by the Examiner (Ans. 18-19), Appellant’s Specification explains that “[u]pdating can also be totally automatic, and . . . be completely invisible to or transparent to the user, running in background on their system, while the user’s screen is available for other processing such as running the containing information product 12” (emphasis added). (Spec. 12:23-26.) Under the broadest reasonable interpretation consistent with the Specification, we agree with the Examiner’s construction that “background” means “completely invisible to or transparent to the user.” The Examiner further found that “an artisan skilled in the art would readily understand that having an application program running ‘in the background’ while a GUI is operating is a multitasking operating system.” (Ans. 19.)

Furthermore, we elaborate and highlight our original Decision to replace the full sentence at page 5, lines 23-25, with the following:

Kleinerman also explains that when the AIM is invoked (col. 17, ll. 31-37) such that a session window remains “invisible to the user” (col. 18, ll. 3-9), and therefore, teaches the limitation “in the background, thereby permitting the graphical user interface to continue operation.” Modifying Kleinerman such that an API operates “invisible to the user” in a multitasking environment (i.e., one task runs in the foreground while another task runs in the background) is merely the combination of known computing elements, to yield predictable results. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007).

Last, Appellant also argues that “as compared to the Examiner’s rejection, the Board has changed which portions of Kleinerman the Office alleges to correspond to the claim limitations in such a way that is tantamount to a new ground of rejection.” (Req. for Reh’g 9.)

However, it is not a new ground of rejection for the Board to respond to Appellant’s arguments using different language, or restating the reasoning of the rejection in a different way, so long as the evidence relied upon is the same and the “basic thrust of the rejection” is the same. *See In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). In particular, citing to a different portion of an applied reference, which “goes no farther than, and merely elaborates upon, what is taught by” the previously-cited portion of that reference relied upon by the Examiner, does not constitute a new ground of rejection. *See In re DBC*, 545 F.3d 1373, 1382 n.5 (Fed. Cir. 2008).

The Decision cited to different portions of Kleinerman instead of relying on official notice in concluding that combination of Kleinerman, RIPscrip, Microsoft, and Zellweger would have rendered obvious independent claim 114, which includes the limitation “a response to the

functional request from the online service in the background, thereby permitting the graphical user interface to continue operation.” Thus, because the basic thrust of the rejection is the same, Appellant has been afforded a fair opportunity to respond to the rejection. *See Kronig*, 539 F.2d at 1303.

CONCLUSIONS

The Request for Rehearing has been considered. As discussed previously, we grant the Request for Rehearing to further elaborate and highlight: (i) page 4, lines 6-12; and (ii) page 5, lines 7-14, 15-19, and 23-25 of our original Decision. The Request for Rehearing is otherwise *denied*. Accordingly, the Request for Rehearing is *granted-in-part*.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING GRANTED-IN-PART

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